

REMARKS

I. CLAIM REJECTION – 35 USC § 101

The Examiner on page 2 states “[c]laims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.” Applicant respectfully traverses this rejection.

The Examiner further states on page 2 “[t]he method as claimed is implemented by a human being and not by a machine. The subject matter claimed therefore is not statutory.” The Examiner cited 35 USC § 101 in support of this proposition which states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title. (underlining added)

As can be seen, both processes and machines are statutory subject matter under 35 USC § 101. Importantly, there is no requirement in 35 USC § 101 that claimed processes be performed by machines. Thus, Applicant respectfully submits that the claims are directed towards statutory subject matter.

Perhaps the Examiner was referring to MPEP 2106.02 which states in part:

If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Gottschalk v. Benson*, 409 U.S. 63, 71 - 72, 175 USPQ 673, 676 (1972). Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

While MPEP 2106.02 removes “abstract concepts” and processes consisting “solely of mathematical operations” from being statutory subject matter, claims 1-21 include real world instrumentalities. As examples, one cannot create a web site on the Internet accessible to Entrepreneurs, register an available domain name or offer hosting services purely in one’s head. These limitations require real world instrumentalities that extend beyond the abstract. Thus, claims 1-21 are not purely abstract concepts or solely mathematical operations and Applicant respectfully requests the withdrawal of this rejection.

II. CLAIM REJECTIONS – 35 USC § 103

A) Not all elements are taught by Jacobs.

The Examiner on page 3 states “[i]n Jacobs, the created web site is not for assisting an entrepreneur in creating an Internet business.” (emphasis added) This is the purpose of the “Facilitator’s web site” as described throughout the specification. Thus, Jacob does not teach the “Facilitator’s web site” (or the preamble) of element A of claims 1, 6, 13, 20, and 21.

MPEP 2143.03 states in part “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since not all of element A (at least the Facilitator’s web site) of claims 1, 6, 13, 20, and 21 are taught by Jacobs, these claims (and their dependent claims) should be allowed.

B) Missing elements from Jacobs are not inherent

The Examiner on page 3 continues with “[s]teps B, C and D are essential steps for a business conducted via a web site (Internet business).” The Examiner did not provide a cite for an “essential step” rule. However, MPEP 2112 IV dealing with inherency states in relevant part:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Thus, to be inherent “the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.” (emphasis added) Applicant respectfully submits that steps B, C and D are not necessary (or “essential” as stated by the Examiner) for an Internet business. Specifically, an Entrepreneur may perform the prior art method of going to one website to register a domain name, a second website to assist in designing the Entrepreneur’s website, and yet a third website to obtain hosting services. Since Jacobs may be practice using prior art methods, steps B, C and D are not inherent in Jacobs.

C) The invention is not obvious since the problem it solved was not obvious.

The Examiner continues on page 3 with “[i]f the created web site is for assisting an Entrepreneur in creating an Internet Business, it would have been obvious to include steps B-D in the created web site because they are inherent steps (essential steps, without them Internet business is impossible). Applicant respectfully submits there are three problems with this statement.

First, the Examiner states “[i]f the created web site is for assisting an Entrepreneur in creating an Internet Business, . . .” However, the Examiner earlier admitted that in Jacobs “the created web site is not for assisting an entrepreneur in creating an Internet business.” Thus, Jacobs does not meet the Examiner’s own initial condition required for the Examiner’s obviousness argument.

Second, as described above, the steps are not inherent or essential since Jacobs may be practiced using the prior art methods.

And third, the invention is not obvious for at least the reason that it solved a problem that was not obvious.

MPEP 2141.02 III states in part:

[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969).

There are no teachings in Jacob that going to different websites to obtain domain name registration, website design and hosting services (or other services) was a “problem”. Thus, under MPEP 2141.02 III, Applicant’s invention may be patented even if (and Applicant does not admit this) “the remedy may be obvious once the source of the problem is identified.” Since Jacobs does not identify the problem, it cannot make the solution obvious (even if the solution is obvious once the problem has been identified).

D) Amended dependent claims 2-5, 7-12, and 14-19 are not obvious.

The Examiner on page 3 states “[i]t would have been obvious to a person of ordinary skill in the art to incorporate the services in the created web site which are needed to establish the specific type of Internet business the entrepreneur selected to establish so that he is able to start a business.” Even if this is true, it does not accurately characterize the amended limitations in the claims. The limitations in claims 2-5, 7-12, and 14-19 have been amended to make it clear that a Facilitator’s web site (and not a plurality of different web sites as is known in the prior art) provides all the claimed steps. Using a single Facilitator’s web site to provide the various claimed combination of steps is not taught or made obvious by Jacobs. This is particularly true since the Examiner has admitted that while “Jacobs teaches a method for creating a web site,” Jacobs does not teach any of the other claimed steps.

CONCLUSION

Applicant respectfully submits that not all of the claim limitations are taught by Jacobs for claims 1-21 as explained above and Jacob does not make claims 1-21 obvious. Applicant thus requests the allowance of all pending claims, i.e. claims 1-21, as soon as possible. Any questions or suggestions regarding this Amendment should be directed to the undersigned attorneys for Applicants at the telephone number or email address listed below.

Respectfully submitted,

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